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REMARKS

Claims 16, 19-20, 32-39 and 157-165 were pending in the subject application. Applicants have amended claims 16 and 157. Accordingly, claims 16, 19-20, 32-39 and 157-165 are currently pending.

Applicants are pleased to note that in view of their June 4, 2004 Amendment, the Examiner has withdrawn the rejections of claims 16, 18-20 and 32-39 under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement.

Withdrawn claims 157-165

Applicants have amended withdrawn claim 157 to depend on an incorporate all of the limitations of claim 16, which applicants believe is in condition for allowance in its amended form. Thus, claim 16 is a linking claim to claim 157 and all claims dependent thereon in accordance with M.P.E.P. §809.03. Furthermore, according to M.P.E.P. §809.04, once a linking claim is found allowable, as amended claim 16 should be, all claims linked by it should be rejoined. Accordingly, claims 157-165 should be rejoined in the subject application.

Rejection under 35 U.S.C. §102

In section 2 of the September 13, 2004 final Office Action, the Examiner maintained the rejection of claims 16, 19 and 32-39 under 35 U.S.C. §102(b) as allegedly anticipated by Arnon, et al. (Israel J. Med. Sci. [1989] 25:686-689). The Examiner stated that the applicant's arguments filed June 4, 2004 have been fully considered but they are not persuasive.

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The Examiner noted the applicants' assertion that the COP 1 copolymer of Arnon does not anticipate the instant copolymer because the copolymer of Arnon comprises four different amino acid residues: glutamic acid, lysine, tyrosine and alanine, whereas page 1 of the instant specification defines a "terpolymer" (as recited in the claims) as "consisting essentially of" only three of the four amino acid residues found in COP 1. However, the Examiner maintained that the phrase "consisting essentially of" does not exclude additional non-recited elements provided that the additional elements do not materially affect the basic and novel characteristic(s) of the claimed invention. On this basis, the Examiner concluded that the recitation of "consisting essentially of" in the instant claims and in the definition of the term "terpolymer" does not exclude the presence of glutamic acid simply because the copolymer of Arnon contains a lot of it.

In response, applicants maintain that the Examiner has impermissibly broadened the scope of claim 16 and specifically the phrase "consists essentially of" by alleging that Arnon anticipates the claims of the subject application. *SciMed Life Systems, Inc. V. Advanced Cardiovascular Systems, Inc.*, 242 F.3d 1137, 1141 (Fed. Cir. 2001) ("Where the specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question.")

However, without conceding the correctness of the Examiner's comments and solely to advance the prosecution of the subject application, applicants have amended claim 16 to recite

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"wherein each terpolymer consists of randomly polymerized tyrosine, alanine and lysine". Accordingly, claims 16, 19 and 32-39 are now in condition for allowance and the rejection under 35 U.S.C. 102(b) based on Arnon, et al. (Israel J. Med. Sci. [1989] 25:686-689 should be withdrawn.

**Rejection under 35 U.S.C. §103**

In section 3 of the September 13, 2004 final Office Action the Examiner maintained the rejection of Claims 16, 19, and 32-39 under 35 U.S.C. §103(a) as allegedly unpatentable over Teitelbaum et al (Proc. Nat. Acad. Sci. [1988] 85(24):9724-9728) in view of Arnon, et al. (Israel J. Med. Sci. [1989] 25:686-689).

The Examiner noted the applicants' assertion that the combined references do not render the instantly claimed invention obvious for the same reasons that applicants asserted that the claims are not anticipated by Arnon *supra*, namely, that the instant copolymers are non-obviousness because the copolymer of Teitelbaum comprises four different amino acid residues (glutamic acid, lysine, tyrosine and alanine), whereas the instantly disclosed terpolymer "consists essentially of" only the three amino acid residues alanine, lysine, and tyrosine. However, the Examiner maintained that the phrase "consisting essentially of" does not exclude additional non-recited elements provided that the additional elements do not materially affect the basic and novel characteristic(s) of the claimed invention. Therefore, the Examiner concluded that the recitation of "consisting essentially of" in the instant claims and in the definition of the term "terpolymer" does not exclude the presence of glutamic acid simply because the copolymer of Teitelbaum contains a lot of it.

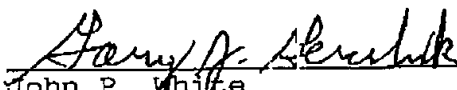
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In response, applicants maintain, as noted above, that the Examiner has impermissibly broadened the scope of claim 16. However, as also noted above, applicants have amended claim 16 to recite "consists of". Accordingly, claims 15, 19, and 32-39 are now in condition for allowance and the rejection under 35 U.S.C. 103(a) based on Teitelbaum et al (Proc. Nat. Acad. Sci. [1988] 85(24):9724-9728) in view of Arnon, et al. (Israel J. Med. Sci. [1989] 25:686-689) should be withdrawn.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is deemed necessary, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,

  
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